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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/511,633

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Rolf Kawa

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EXAMINER

SULLIVAN, DANIELLE D

ART UNIT

PAPER NUMBER

1616

NOTIFICATION DATE

DELIVERY MODE

05/13/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@foxrothschild.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/511,633	<b>Applicant(s)</b> KAWA ET AL.	
	<b>Examiner</b> DANIELLE SULLIVAN	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-25, 27-38, 42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) 42 and 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-25 and 27-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 21-25, 27-38, 42 and 43 are pending.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/05/2009 has been entered.

#### ***Election/Restrictions***

### **DETAILED ACTION**

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 21-25, 27-38, drawn to a composition, classified in class 424, subclass 401.
- II. Claims 42 and 43, drawn to method of applying a foam, classified in class 514, subclass 945.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process

Art Unit: 1616

for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the composition can be used in a method of cleaning hair instead of protecting skin.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined** even though the requirement

Art Unit: 1616

may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Newly submitted claims 42 and 43 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 21-25, 27-38 and claims 42 and 43 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process

Art Unit: 1616

for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the composition can be used in a method of cleaning hair instead of protecting skin.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 42 and 43 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polovsky et al. (5,384,334) in view of Ansmann et al. (US 6,280,712).

### **Applicant's Invention**

Applicant claims a protection water-in-oil emulsion comprising: a) at least on polyol poly-12-hydrostearate, particularly comprising poly(12-hydroxystearic acid) polyglycerol ester (preferably 2-10%); b) an oil component, particularly dialkyl carbonate (preferably 1-20%); c) at least on surfactant selected from anionic, zwitterionic or

Art Unit: 1616

mixtures thereof, particularly a mixture of Cocamidopropylbetaine and a sulfosuccinate (preferably 0.5-10%); of a UV protection factor (preferably 0.5-20%); and water (preferably 30-80%).

### **Determination of the scope and the content of the prior art**

#### **(MPEP 2141.01)**

Polovsky et al. teach stable personal care compositions comprising alkoxyated alkyl glucosides that may be formulated as water-in-oil emulsions have mild effects to skin and hair (abstract; column 7, lines 41-47). Additives include sulfosuccinates, cocamidopropyl betaine and sunscreens (column 7, line 60; column 8, lines 10 and 44-49). The alkyl glucoside, MG10HDAC1, is present in the amount of 2.5% the composition (column 9, line 65; Example 5).

### **Ascertainment of the difference between the prior art and the claims**

#### **(MPEP 2141.02)**

Polovsky et al. do not teach the polyol poly-12-hydroxystearate or the specific oil component, dialkyl carbonate. Neither are specific ranges of percent weight given. It is for this reason that Ansmann et al. is joined.

Ansmann et al. teach a process for enhancing the effectiveness of a sunscreen's UV filter by using dialkyl ethers (abstract, column 1, lines 37-46). The dialkyl carbonates may be used in a quantity of 1-30% by weight (column 2, lines 11-14). The compositions may contain mild surfactants, e.g., dialkylsulfosuccinates and cocamidopropyl betaine (column 4, line 15; column 5, line 55), oil components, emulsifiers, such as polyol esters of poly-12-hydroxystearate and alkyl glucosides

Art Unit: 1616

(column 4, lines 59-62; column 5, line 3) and super-fatting agents to stabilize foams (column 4, lines 5-12; column 6, lines 8 and 12). The alkyl glucosides are taught as equivalents of polyglycerol poly-12-hydroxystearates which may be used in combination. The total percentage of additives may be from 1 to 50% by weight, based on the particular formulation. Water is added to bring the composition to 100 (Table 2, line 64).

### **Finding of prima facie obviousness**

#### **Rationale and Motivation (MPEP 2142-2143)**

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Polovsky et al. and Ansmann et al. to further include poly-12-hydroxystearate. One would have been motivated to include poly-12-hydroxystearate because it is a known cosmetic emulsifier and is taught as a functional equivalent of alkyl glucosides taught by Ansmann et al. Therefore, a skilled artisan would have been motivated to add poly-12-hydroxystearate to have the added benefit of a mild effect to skin as taught by Polovsky et al.

Regarding claim 38, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Polovsky et al. and Ansmann et al. to further include dialkyl carbonates as the oil component. One would have been motivated to include dialkyl carbonates because they enhance the effectiveness of sunscreens as taught by Ansmann et al. It is prima facie obvious to utilize any known emulsifier and oil component absent any showing of unexpectedness.



Polovsky et al. does not disclose any particular ranges of poly-12-hydroxystearate but discloses the equivalent, alkyl glucoside, as present in 2% the composition. Ansmann et al. teaches dialkyl carbonates may be used in a quantity of 1-30% by weight the composition with a total percentage of additives from 1 to 50% by weight with water added to bring the composition to 100. The particular additives include poly-12-hydroxystearates and surfactants.

It would have been obvious to a skilled artisan to manipulate the concentrations within the given ranges provided in the prior art. One would have been motivated to optimize the concentration through routine experimentation to find the optimal workable range.

### ***Response to Arguments***

Applicant's arguments filed 6/05/2009 have been fully considered but they are not persuasive. Applicants argue Polovsky teaches cationic surfactants because the alkoxyated alkyl glucosides have quaternary nitrogen ether substituents which cause them to have different physicochemical properties than nonionic alkoxyated alkyl glucosides. The Examiner is not convinced by this argument because Polovsky does not teachaway from the use of nonionic surfactants. Furthermore, only claims 24 and 37 specify the limitation that the surfactants are anionic or zwitterionic. The Ansmann reference teaches that nonionic surfactants include polyglycerol poly-12-hydroxystearate and alkyl glucosides. Hence, in view of KSR International Co. v. Teleflex Inc., 550 U.S., 82 USPQ2d at 1396, it would have been obvious to combine the

Art Unit: 1616

teachings of Polovsky and Ansmann because adding surfactants would yield predictable results.

Applicants next argue that Ansmann fails to recognize the advantage of poly-12-hydroxystearates with regard to generating a foam. The Examiner is not persuaded by this argument because the claims are drawn to a composition and Polovsky teaches foam mousse compositions (Example 6). Hence, it would have been within the skill of one ordinary in the art to make a formulation in the form of a foam.

Claims 21-25 and 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polovsky et al. (5,384,334) in view of Ansmann et al. (US 6,280,712) in further view of Van der Heijden et al. (WO 00/78629).

### **Applicant's Invention**

Applicant claims a protection water-in-oil emulsion as address in above 103 rejection. Applicant also claims a system of using the composition in a foam dispenser. The dispenser disposes the emulsion with a compressed gas by a pump mechanism combining the emulsion with air to form and dispense foam. The air to liquid mixing ratio is from 5:1 to 30:1 and the shot volume is from 0.1 to 1 ml liquid per shot.

### **Determination of the scope and the content of the prior art**

#### **(MPEP 2141.01)**

Polovsky et al. and Ansmann et al. teach a foamable composition as set forth in the above 103 rejection.

**Ascertainment of the difference between the prior art and the claims**

**(MPEP 2141.02)**

Polovsky et al. and Ansmann et al. do not teach as specific foam mechanism. It is for this reason that Van der Heijden et al. is joined.

Van der Heijden et al. teach the foam dispenser claimed as applicable in the invention (see specification page 27, lines 14-17). The dispenser is taught as useful for dispensing cosmetics (page 1, lines 19-29). It is advantageous to utilize the dispenser for foam compositions because it prevents water from entering the dispensing assembly and contaminating the formulation (page 3, lines 18-20).

**Finding of prima facie obviousness**

**Rationale and Motivation (MPEP 2142-2143)**

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Polovsky et al., Ansmann et al. and Van der Heijden et al. and further include a system of dispensing the foam. One would have been motivated to use the foam dispenser taught by Van der Heijden et al. to provide a pumpable formulation to allow for the ease in application by pumping the formulation. Further, the foam dispenser, as taught by Van der Heijden et al., protects the ingredients in the water-in-oil emulsion from contamination.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danielle Sullivan whose telephone number is (571) 270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Patent Examiner  
Art Unit 1616

/Johann R. Richter/

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Application/Control Number: 10/511,633  
Art Unit: 1616

Page 12